

## **REMARKS**

The Office Action mailed on August 11, 2005 has rejected all of the claims. Claims 1 and 11 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and claim the subject matter which the applicant regards as the invention. Specifically, the Office Action notes that the use of the term ‘optionally’ is vague and indefinite.

The Office Action has further rejected claims 1, 4-20, and 22 under 35 U.S.C. § 102 (e) as being anticipated by US Patent No. 5,748,841 issued to Morin et al. (“Morin”). The Office Action also rejected claims 2, 3, 21 under 35 U.S.C. § 103 (a) as being unpatentable over Morin in view of US Patent No. 6,144,938 issued to Surace et al. (“Surace”).

**Rejection of claims 1 and 11 under 35 U.S.C. § 112, second paragraph**

The Office Action interpreted ‘optionally’ as a limitation to the claim, i.e., a part of the claim. Applicants concur with this interpretation, which is also in keeping with the usual interpretation of claims because limitations within claims are not optional. Limitations in claims, however, may describe choices in the substantive description of the invention for clarity. Applicants thank Examiner Spooner for expediting the examination of the application.

In view of this clarification, based on the filed specification, the rejection of claims 1 and 11 under 35 U.S.C. § 112, second paragraph has been overcome and the record of the this application provides the required clear notice.

**Rejection of claims 1, 4-20 and 22 under 35 U.S.C. § 102**

Morin discloses a system for prompting a user to assist with learning and using a programming language or procedure for operating devices and equipment. It accepts a limited amount of natural language input by a user. It differs from the claimed and disclosed invention at least in its intrinsic design as Morin seeks to prompt a user to use a suggested choice. The claimed invention on the other hand, establishes a broader and different context for processing of the natural language input.

One manifestation of this is in that a user can start by querying the system of the claimed invention and then establish a context. Morin's context is established based on application scripts, see, e.g., column 3:13-17.

Applicants have amended the independent claims to emphasize a result of these differences to better define their invention. The amended independent claims 1, 11 and 22 all recite a limitation of providing at least one of a superlative and a comparison of the first information based on the context information, wherein the first information includes a plurality of items that can be compared with each other.

The Office Action claims this limitation is found in Morin inherently in its reasons for rejecting claims 10 and 20. Applicants respectfully disagree. Rejections based on inherency need to demonstrate that the limitation is necessarily present for the disclosure of Morin to work. The Office Action apparently limits itself to stating the belief that the statement "if the inputted expression makes sense in the dialogue context it will be interpreted . . ." meets the limitation. This statement is clearly inadequate as it lacks any details relating to superlatives or plurality of items or any other substantive detail. The relied upon statement is a tautology rather than a description.

Morin, given its focus on assisting a user with interfacing with programming a device, does not even suggest the limitation added to all of the independent claims. If the rejection based on inherency is maintained, then it is respectfully requested that more details be provided to flesh out the intended link between the relied upon portions of Morin and the claimed invention to allow a response to be formulated.

In view of the patentability of all of the independent claims, 1, 11 and 22, pending claims dependent upon any of them are axiomatically patentable. Therefore, their rejections should be withdrawn.

**Rejection of claims 2, 3, and 21 under 35 U.S.C. § 103**

As demonstrated above, all of the independent claims are patentable over Morin because Morin does not disclose, teach or suggest all of the limitations of the claimed invention. The exemplary limitation missing in Morin is not provided by Surace. Therefore, axiomatically, Surace cannot cure the shortcomings of Morin. Therefore, claims 2, 3, and 21 are also patentable over the cited art.

## CONCLUSION

This response is timely today because February 11, 2006 was a Saturday. No fees are estimated to be due for this response other than that required for the enclosed Petition for Extension of Time for three months, which fee is estimated to be \$510.00. Please charge any required fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,



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Enclosure